



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,601	10/14/2003	Frederic Guerin	PO7959/PO-11114	4241

34947 7590 05/24/2006

LANXESS CORPORATION
111 RIDC PARK WEST DRIVE
PITTSBURGH, PA 15275-1112

EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,601

Applicant(s)

GUERIN ET AL.

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/13/2006 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. All outstanding rejections, unless given below, are withdrawn in light of applicant's amendment filed 3/13/2006.

Specification

4. The disclosure is objected to because of the following informalities: at the bottom of page 8, "Formula VI" should be read as "Formula IV" since it is the fourth formula.

Appropriate correction is required.

Claim Objections

5. Claim 1 is objected to because of the following reasons:
 - In lines 18-19 and the 2nd and 3rd last lines of the claim, the phrase "(which are especially preferred)" should be deleted since preferred and non-preferred embodiments are given equal weight when alternatively recited.
 - In line 29, "a anionic ligand" should be replaced with "an anionic ligand."

Art Unit: 1714

- In line 30, the term “they” should read as “it” since there is only one L^2 ligand.
- Formula IV also appears to be misplaced and should be inserted after the full description of Formula III.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the phrase “such as” in line 17 and the 4th to last line of the claim renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

With respect to claim 4, the term “comprises” is inconsistent with the closed claim language “consisting of” of independent claim 1. Furthermore, a curing system does not fall within the scope of claim 1 since a curing system is different from a crosslinking agent. The terms “crosslinking agent” and “curing system” are used in the alternative in applicant’s specification on page 14, line 24-28.

With respect to claims 2, 3, and 5, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 102/103

7. Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oyama et al (US 5,651,995).

Art Unit: 1714

The rejection is adequately set forth in paragraph 7 of Office action mailed 9/14/2005 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al (WO 97/36956) in view of Rau et al (6,187,867).

The rejection is adequately set forth in paragraph 9 of Office action mailed 9/14/2005 and is incorporated here by reference.

Double Patenting

Three obviousness-type double patenting rejections are set forth below.

Double Patenting, I

9. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-14, 16, and 17 of copending Application No. 10/728,029 (published as US PGPub 2004/0132891).

The discussion in paragraph 11 of Office action mailed 9/14/2005 is incorporated here by reference.

While US '029 does not claim a polymer composite comprising a nitrile rubber prepared with a metathesis catalyst, the presently claimed metathesis catalyst are taught on page 5, line 10 to page 8, line 4 of US '029's specification. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered

Art Unit: 1714

when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Applicant's statement on page 10 of the amendment filed 3/13/2006 regarding the provisional obviousness-type double patenting rejection is acknowledged. If this double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

Double Patenting, II

10. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/684,867 (published as US PGPub 2004/0113320).

The rejection is adequately set forth in paragraph 12 of Office action mailed 9/14/2005 and is incorporated here by reference.

Applicant's statement on page 10 of the amendment filed 3/13/2006 regarding the provisional obviousness-type double patenting rejection is acknowledged. If this double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

Double Patenting, III

11. Claims 1-3 and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,780,939 alone or in view of

Art Unit: 1714

Oyama et al (US 5,651,995). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

US '939 claims a shaped article of a composition comprising a hydrogenated nitrile rubber having a Mooney viscosity of 3-50 and a polydispersity index of less than 2.5

US '939 does not claim that the nitrile rubber is prepared by the presently claimed metathesis catalysts, however, note col. 4, line 23 to col. 5, line 59 where US '939 teaches the use of metathesis to obtain the hydrogenated nitrile rubber. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

While '939 does not disclose a filler, given that it is used in shaped articles which conventionally utilize a filler, it would have been obvious to one of ordinary skill in the art to add a filler to the composition of US '939. Evidence to support the examiner's position is found in Oyama et al which discloses gaskets, seals, belts, etc (col. 33, lines 16-38) and teaches the use of fillers in such articles (col. 13, lines 47-53).

12. Claims 1-3 and 5 are directed to an invention not patentably distinct from claim 2 of commonly assigned U.S. Patent No. 6,780,939. Specifically, see the discussion set forth in paragraph 11 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,780,939, discussed above, would form the basis for a

Art Unit: 1714

rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

13. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,780,939 in view of Oyama et al (US 5,651,995). See the discussion set forth in paragraph 11 above.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

Art Unit: 1714

the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Conclusion


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/22/2006
Vickey Ronesi




VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700